



030727.0013.CIP1
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Erion *et al.*

Serial No.: 09/518,501

Filed: March 3, 2000

Title: NOVEL PHOSPHORUS-CONTAINING
PRODRUGS

Group Art Unit: 1624

Examiner: McKenzie, T.

Box AF
Commissioner for Patents
Washington, D.C. 20231

INTERVIEW SUMMARY

On November 20, 2002, Examiner McKenzie conducted a telephonic interview with Applicants' attorneys Jessica Wolff and Diana Bush, Applicants' patent agent, Cynthia O'Donohue, and Dr. Mark Erion, with regard to Application No. 09/518,501. Application Nos. 09/747,182 and 09/801,933 were also discussed.

In regard to this Application, the following topics were discussed:

1. Examiner's indefiniteness and lack of enablement rejections for the term "prodrug" in claims 1-18, 20-46, 48-57, 150-157, and 165.

The Examiner indicated that he would give favorable consideration to a declaration saying that a person of ordinary skill in the art could easily determine what is or is not a prodrug and that the preparation of prodrugs is routine. The Examiner also indicated that he would consider any publications showing the successful preparation and testing of prodrugs.

2. Examiner's indefiniteness and lack of written description rejections based on the provisos "M is not -NH(lower alkyl), -N(lower alkyl)₂..." in claims 1-3, 7, 9-18, 20-46, 48-53, 150-157, 165-166, and 171-173.

CERTIFICATE OF MAILING
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The Applicants indicated that they did not understand this rejection and asked the Examiner to explain the rejection further.

The Examiner explained that his rejections were based on his belief that the compounds excluded by these provisos were not biologically active and therefore not claimed compounds. The Examiner agreed that if the compounds are biologically active, then the claims are not indefinite. The Examiner agreed that when the indefiniteness rejection is removed, the lack of written description rejection will also be removed.

Respectfully submitted,

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